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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,621	01/24/2002	Richard C. O'Brien	618-1047	5284

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PENNIE & EDMONDS LLP  
1667 K STREET NW  
SUITE 1000  
WASHINGTON, DC 20006

EXAMINER

LE, HUYEN D

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 10/03/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/053,621

Applicant(s)

O'BRIEN ET AL.

Examiner

Huyen Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-21, 23-26, 30, 32-39 is/are rejected.
- 7) ☒ Claim(s) 7, 22, 27-29 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 8-10, 25, 26, 30, 32-39, are rejected under 35 U.S.C. 102(b) as being anticipated by Lin (6,200,050).

The Lin reference discloses a barrel 1 having a channel with an opening end and a side surface (inside the barrel); an actuator 421 located on the side surface of the barrel; a writing element 2 disposed in the channel and movable along a longitudinal axis between a retracted position and an extended position; a least a portion of said writing element 2 is resilient; a writing element 2 is deflected in a direction substantially transverse to the longitudinal axis upon being moved into the extended position; and the resiliency of the writing element 2 biases the writing element 2 to engage the channel and to retain the writing element 2 in the extended position.

Regarding claim 3, the writing instrument comprises a first engagement member 422 associated with the writing element 2, wherein the first engagement member 422 engages the channel.

Regarding claim 4, the first engagement member 422 is a pawl.

Regarding claim 5, the writing instrument comprises a second engagement member 13.

Regarding claim 6, the second engagement member 13 is an indentation formed on the channel.

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Regarding claim 8, the writing instrument comprises a sleeve member 42 disposed in the channel for receiving a portion of the writing element, wherein the sleeve member 42 engages the channel to retain the writing element in the extended position.

Regarding claim 9, the writing instrument comprises a first engagement member 422 located on the sleeve member 42.

Regarding claim 10, the writing element 2 is a living spring.

Regarding claim 25, the actuator member 421 is disposed on a side surface (inside) of the barrel 1 and the actuator member 421 bends down and up when it moves along non-linear path between a first position and a second position, and thus, it moves along non-linear path.

Regarding claim 26, the actuator member 421 pivots as it moves between the first position and the second position.

Regarding claim 32, the writing instrument comprises a sleeve member 42 disposed in the channel, the sleeve member 42 is pivotally couple to the actuator member 421

Regarding claim 33, the writing element 2 returns to a substantially straight configuration when in the extended position.

Regarding claim 34, the writing instrument comprises a release member 411 located on a side surface of the barrel.

Regarding claim 36, the release member 411 is a cantilever beam.

Regarding claim 37, the writing instrument comprises a protrusion constituting a grip element covering at least a portion of the release member 411.

Regarding claim 38, the release member 411 is pivotally coupled to the barrel 1.

3. Claims 1-6, 8-16, 19, 20, 23-26, 30, 33, 34, 36, 37, 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Felgentreu (DE 3922777).

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The Felgentreu reference discloses a barrel 1 having a channel with an opening end 3 and a side surface; an actuator 13 located on the side surface of the barrel; a writing element 10 disposed in the channel and movable along a longitudinal axis between a retracted position and an extended position; a least a portion of said writing element 10 being resilient; a writing element 10 deflected in a direction substantially transverse to the longitudinal axis upon being moved into the extended position; and the resiliency of the writing element 10 biasing the writing element 10 to engage the channel and to retain the writing element 10 in the extended position.

Regarding claim 3, the writing instrument comprises a first engagement member 17 associated with the writing element 10, wherein the first engagement member 17 engages the channel.

Regarding claim 4, the first engagement member 17 is a pawl.

Regarding claim 5, the writing instrument comprises a second engagement member 5.

Regarding claim 6, the second engagement member 5 is an indentation formed on the channel.

Regarding claims 8 and 23, the writing instrument comprises a sleeve member 12 disposed in the channel for receiving a portion of the writing element 10, wherein the sleeve member 12 engages the channel to retain the writing element 10 in the extended position.

Regarding claim 14, the writing instrument comprises a release member 15 located on a side surface of the barrel 1 and movable from a rest position to a release position; wherein movement of the release member 15 to the release position disengages the writing element 10 from the channel.

Regarding claim 19, the release member 15 is a cantilever beam.

Regarding claim 24, the writing instrument comprises a first engagement member 17 located on the sleeve member 12

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Regarding claim 25, the actuator member 13 moves in a L-shaped groove which is a non-linear path.

Regarding claim 26, the actuator member 13 pivots as it moves between the first position and the second position.

Regarding claim 32, the writing instrument comprises a sleeve 12 disposed in the channel, wherein the sleeve member 12 is pivotally coupled to the actuator member 13.

4. Claims 1-3, 10-18, 20, 25, 30, 33-35, 37 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu (5,599,122).

The Yu reference discloses a barrel 1 having a channel with an opening end and a side surface; an actuator 25 located on the side surface of the barrel 1; a writing element 11 disposed in the channel and movable along a longitudinal axis between a retracted position and an extended position; a least a portion of the writing element 11 being resilient; a writing element 11 deflected in a direction substantially transverse to the longitudinal axis upon being moved into the extended position; and the resiliency of the writing element 11 biasing the writing element 11 to engage the channel and to retain the writing element 11 in the extended position.

Regarding claim 3, the writing instrument comprises a first engagement member 25 associated with the writing element 11, wherein the first engagement member 11 engages the channel.

Regarding claims 14 and 34, the writing instrument comprises a release member 21 located on a side surface of the barrel 1 and movable from a rest position to a release position; wherein movement of the release member 21 to the release position disengages the writing element 11 from the channel.

Regarding claim 17, a portion 24 of the release member 21 contacts the first engagement member 25

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Regarding claims 20 and 37, the writing instrument comprises a grip element 21 covering at least a portion of the release member.

Regarding claim 25, the actuator member 25 moves in a-L shape path which is straight down toward the opening end of the barrel and into the barrel. Thus the actuator member 24 moves along a non-linear path.

Regarding claim 34, the writing instrument comprises a release member 21 located on a side surface of the barrel.

Regarding claim 39, the writing instrument comprises a second engagement 14 associated with the channel, wherein the first engagement member 25 engages the second engagement member 14.

#### ***Allowable Subject Matter***

5. Claims 7, 22, 27-29 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Le whose telephone number is 703-306-5504. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

HL  
September 30, 2003

  
MICHAEL MAR  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700